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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,932	03/22/2004	Michael K. Brown	555255012483	1029
7590 09/25/2007 John V. Biernacki, Esq. Jones Day 901 Lakeside Avenue/North Point Cleveland, OH 44114			EXAMINER AJAYI, JOEL	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 09/25/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/805,932	Applicant(s) BROWN ET AL.	
	Examiner Joel Ajayi	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

The office action mailed on July 13, 2007 is hereby withdrawn and vacated.

This action is in response to Applicant's amendment filed on April 26, 2007. **Claims 1-29** are still pending in the present application. **This action is made FINAL.**

#### ***Response to Arguments***

Applicant's arguments filed April 26, 2007 have been fully considered but they are not persuasive.

The argument features a secure message that is processed at the server in order to locate within the secure message the second attachment.

The examiner respectfully disagrees with the applicant's statement and asserts that Dunnion et al. shows a server that processes a user's request for the message content, including attachment(s), of a secure email (paragraph 128, lines 1-5); the server does this by decrypting the email(s) with a private key (paragraph 138, lines 1-5).

In view of the above, the rejection using Dunnion is maintained as repeated below.

Applicant's arguments with respect to claims 1-25, and 29 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 26-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Dunnion et al.** (U.S. Patent Application Number: 2002/0199119) in view of **Eldridge et al.** (U.S. Patent Number: 6,397,261).

Consider **claim 26**; Dunnion clearly discloses an apparatus located at a computer server for handling secure message attachments for a mobile device, wherein the server receives a secure message containing a second attachment (the messages handled by the server are secure) (paragraph 124, lines 1-15; paragraph 128, lines 1-5), comprising: a data store that stores the

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secure message and the second attachment (paragraph 124, lines 1-15); wherein the secure message contains a secure layer such that the secure message itself is received by the server as a first attachment (paragraph 128, lines 1-5); a secure message handling module that looks into the secure message through the secure layer in order to locate the second attachment (the server decrypts the email) (paragraph 138, lines 1-5); wherein the second attachment is provided to the mobile device (the unencrypted message composed by the originator is provided to the user) (paragraph 139, lines 1-14).

Dunnion fails to disclose processing at the server the secure message.

In the same field of endeavor Eldridge clearly discloses processing at the server the secure message (column 2, lines 52-63).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Eldridge into the method of Dunnion in order to provide secure document services, e.g. emailing, on a network.

Consider **claim 27**; Dunnion discloses that the second attachment is automatically provided by the server to the mobile device when the secure message is opened by the mobile device's user (paragraph 137, lines 1-5).

Consider **claim 28**; Dunnion discloses that the secure message is structured such that a secure layer has been added to the message and the second attachment (paragraph 128, lines 1-5).

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**Claims 1, 2, 5-25, 29** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Dunnion et al. (U.S. Patent Application Number: 2002/0199119)**.

Consider **claim 1**; Bouchard discloses a method for handling secure message attachments for a user (paragraph 51, lines 1-17), comprising the acts of: receiving at a server a second attachment provided within a secure message (Bouchard refers to a number of attachments) (paragraph 51, lines 1-17); wherein the secure message itself was received by the server as a first attachment (paragraph 51, lines 1-17); requesting the second attachment at the user (in order for the server to process the message it has to be requested by the user) (paragraph 64, line 1 – paragraph 65, line 13); processing at the server the secure message in order to locate within the secure message the second attachment (paragraph 64, line 1 – paragraph 65, line 13); and providing the second attachment to the user (paragraph 64, line 1 – paragraph 65, line 13).

Bouchard fails to disclose a mobile device.

In the same field of endeavor Dunnion clearly discloses that the client is a mobile device (paragraph 52, lines 1 and 2).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Dunnion into the method of Bouchard in order to provide security services to users.

Consider **claim 29**; Bouchard discloses an apparatus located at a computer server for handling secure message attachments for a user (paragraph 51, lines 1-17), comprising: means for receiving a second attachment provided with a secure message (paragraph 51, lines 1-17); wherein the secure message itself was received by the server as a first attachment (paragraph 51,



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lines 1-17); means for handling the secure message in order to locate within the secure message the second attachment (paragraph 64, line 1 – paragraph 65, line 13); means for providing the second attachment to the user (paragraph 64, line 1 – paragraph 65, line 13).

Bouchard fails to disclose a mobile device.

In the same field of endeavor Dunnion clearly discloses that the client is a mobile device (paragraph 52, lines 1 and 2).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Dunnion into the method of Bouchard in order to provide security services to users.

Consider **claim 2**; Bouchard discloses that the secure message is structured according to a security scheme such that the secure message is handled as an attachment by the server (the secure message routing system securely communicates messages from one point to another) (paragraph 51, lines 1-17).

Consider **claim 5**; Bouchard discloses that the security scheme is a Secure Multipurpose Internet Mail Extensions (S/MIME) scheme (paragraph 58, lines 1-8).

Consider **claim 6**; Bouchard discloses that the secure message is structured such that a secure layer has been added to the message and the second attachment (paragraph 63, line 8-10).

Consider **claim 7**; Bouchard discloses that the secure layer acts as an envelope with respect to the message and the second attachment (paragraph 64, line 1 – paragraph 65, line 13).

Consider **claims 8, 11**; Bouchard discloses that the secure layer was generated during an encryption operation (paragraph 12, lines 9-11).

Consider **claim 9**; Bouchard discloses that a session key is received by the server from the mobile device for use by the server to decrypt the secure message (paragraph 12, lines 11 and 12).

Consider **claim 10**; Bouchard discloses that the secure layer was generated during a digital signature operation (paragraph 12, lines 9-18).

Consider **claim 12**; Bouchard discloses that the second attachment is selected from the group consisting of: a textual document, word processing document, audio file, image file, or video file (paragraph 51, lines 10-13).

Consider **claims 13-15**; Bouchard discloses that the secure message without the second attachment is sent from the server to the mobile device, wherein the second attachment is provided to the mobile device based upon the mobile device requesting the second attachment (there might be a rule from the recipient, determining how the second attachment is handled) (paragraph 54, lines 9-12; paragraph 56, lines 1-14).

Consider **claim 16**; Bouchard discloses that the secure layer was generated during an encryption operation, wherein a decryption operation is performed in order to locate within the secure message the second attachment (paragraph 12, lines 9-12).

Consider **claim 17**; Bouchard discloses that the secure message has a plurality of attachments (paragraph 51, lines 13-15).

Consider **claim 18**; Bouchard discloses that the server provides an indication to the mobile device that the secure message has the second attachment, wherein the indication is used by the mobile device to indicate to the mobile device's user that the secure message has the second attachment (paragraph 64, line 1 – paragraph 65, line 13).



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Consider **claim 19**; Bouchard discloses that the second attachment is automatically provided by the server to the mobile device when the secure message is opened by the mobile device's user (the recipient does not have to perform any additional steps other than the send and receive steps) (paragraph 65, lines 9-13).

Consider **claims 20**; Bouchard discloses that the second attachment is rendered before being provided to the mobile device (the message is processed) (paragraph 64, line 1 – paragraph 65, line 13).

Consider **claim 21**; Bouchard discloses a means for providing a wireless network and means for providing a message server are used to communicate the located attachment to the mobile device (the process is performed by means of the satellite e-mail server) (paragraph 64, line 1 – paragraph 65, line 13).

Consider **claims 22, 23, 25**; Dunnion discloses that the mobile device is a handheld wireless mobile communications device (paragraph 52, lines 1 and 2).

Consider **claim 24**; Bouchard discloses that the communication channel is a network, wherein the data signal is packetized data that is transmitted through a carrier wave across the network (paragraph 29, lines 1-10).

**Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bouchard (U.S. Patent Application Number: 2003/0115448)** in view of **Dunnion et al. (U.S. Patent Application Number: 2002/0199119)**, and further in view of **Kiessling et al. (U.S. Patent Number: 6,795,924)**.

Consider **claims 3 and 4**; Bouchard and Dunnion clearly disclose the claimed invention except that the security scheme includes a symmetric and asymmetric key scheme.

In the same field of endeavor Kiessling clearly discloses that the security scheme includes a symmetric and asymmetric key scheme (column 2, lines 12-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the teachings of Kiessling into the method of Bouchard and Dunnion in order to provide security solutions for mobile terminals using service data.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

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Examiner should be directed to Joel Ajayi whose telephone number is (571) 270-1091. The Examiner can normally be reached on Monday-Thursday from 7:30am to 5:00pm and Friday 7:30am to 4:00 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

*Joel Ajayi*

  
CHARLES N. APPIAH  
SUPERVISORY PATENT EXAMINER